



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/660,644

09/12/2003

Jurgen Prange

340977US28

7580

22850

7590

09/15/2009

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

SEREBOFF, NEAL

ART UNIT

PAPER NUMBER

3626

NOTIFICATION DATE

DELIVERY MODE

09/15/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 10/660,644	Applicant(s) PRANGE, JURGEN	
	Examiner NEAL R. SEREBOFF	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/31/2009 has been entered.

Response to Amendment

2. In the Amendment filed 3/31/2009, the following has occurred: Claims 1, 8 and 24 have been amended. Now, claims 1 – 27 are pending.

Notice to Applicant

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. In the Office Action dated 7/31/2007, the Examiner made several Official Notice statements. The Applicant's reply, dated 2/11/2008, does not challenge the validity of those Official Notice statements. Therefore, these Official Notice statements become Applicant Admitted Prior Art (AAPA) and they are that:

- The automated instructions are adapted to verify that the sum of all selected postings is in the business's favor.
- One of ordinary skill in the art would have added this feature with the motivation to clearly see all the positions of a business or a customer online to make determining profits easier.

Art Unit: 3626

5. The Examiner notes that this is the first action following the second Request for Continued Examination. In attempting to further prosecution, the Examiner is applying new art. The Examiner is doing so to better explain why the previous rejections were sufficient and why the currently amended claims are still obvious or old.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 15 – 20 and 24 – 27 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 15 – 20 and 24 – 27 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, a § 101 process must (1) be tied to a machine (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski, F.3d , 88 U.S.P.Q.2d 1385 (2008). Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876). The process steps in claims (15 – 20 and 24 – 27) are not tied to a machine nor do they execute a transformation. Thus, they are non-statutory.

The following limitations are not tied to a particular machine:

Claim 15

- instructing the business
 - to make an upcoming payment for an upcoming event,
 - to request a payment from the business from a previous event, or
 - to pair a payment with one or more upcoming events,

Art Unit: 3626

- wherein instructing the business to pair a payment with one or more upcoming events comprises using the list to pair a payment associated with a certain insurance policy with an upcoming event associated with the certain insurance policy.

Claim 24

- instructing the reinsurer to pair a payment with one or more upcoming events,
 - the instructing performed by the insurer using the server associated with the reinsurer,
- wherein instructing the reinsurer to pair a payment with one or more upcoming events comprises using the list to pair a payment associated with a certain insurance policy of the insurer with an upcoming event associated with the certain insurance policy in accordance with an existing reinsurance policy between the insurer and the reinsurer.

Although the list is being displayed on the computer display, it is not clear from these limitations how these instructions are being performed.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1 – 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Regarding claims 1 – 7 and 15 – 22, the independents claim includes:

- “internal records” - it is not clear from the claim to whom these internal records these are related
- “to advise,” “to request,” or “to pair” – it is not clear from the claim who or what performs the actions and who or what receives the actions. Is the advice/ request/ pair being performed mentally?

Art Unit: 3626

- The last limitation includes, “the customer is able to pair a payment associated with a certain insurance policy with a previous event associated with the certain insurance policy”
 - “is able to pair” – it is not clear from the claim whether this step is performed or whether it requires the capability for a pairing to occur
 - The Examiner is unsure how this limitation is performed when the first “to pair” does not occur because of the optional (or) list. The Examiner understands that this limitation is not performed.
- Claims 2 – 7 and 16 –22 are rejected for the same reasons as they depend upon the respective independent claims 1 and 15.

11. Regarding claim 3, the claim includes the limitation, “claim relates to an insurance claim.” There is nothing that describes what is meant by “relates.” Relating may be a words or other nonfunctional descriptive information. Relating may also be a functional relationship that causes another process or step to occur. The Examiner understands relating to be nonfunctional descriptive information.

12. Regarding claims 8 – 14 and 23, the independent claim includes:

- The last limitation includes, “the customer is able to pair a payment associated with a certain insurance policy with a previous event associated with the certain insurance policy”
 - “is able to pair” – it is not clear from the claim whether this step is performed or whether it requires the capability for a pairing to occur
- Claims 8 – 14 and 23 are rejected for the same reasons as they depend upon claim 8.

Art Unit: 3626

13. Regarding claims 24 – 27, the independent claim includes:

- “instructing the reinsurer to pair a payment with one or more upcoming events,” It is not clear how this instruction is performed or whether the instruction would then cause an event to occur.
- Claims 25 – 27 are rejected for the same reasons as they depend upon claim 24.

14. Regarding claim 26, the claim includes, “instructing the reinsurer to make an upcoming payment includes off-setting debit and credit items for the insurer.”

- There is a lack of antecedent basis for “instructing the reinsurer to make an upcoming payment.”
- It is not clear from the claim what is off-set or credited or whether these items are actually off-set or credited.
- The Examiner understands that this limitation is similar to those of claim 24.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. ***Claims 1 – 20, 23, 24, 26 and 27 are*** rejected under 35 U.S.C. 103(a) as being anticipated by Kumar et al., U.S. Pre-Grant Publication 2001/ 0023414 in view of King et al., U.S. Patent 5,704,045.

17. As per claim 1,

Art Unit: 3626

Kumar teaches a system for transacting business between a customer and a business, the system comprising:

- a server used by the business and being accessible by the customer (figure 1, #31 where the location of the server is not claimed),
 - a customer account housed on the server (paragraph 66 – 68),
 - the customer account having access to internal records associated with the customer account on the server (paragraph 67, on-line banking. The Examiner notes that the information required to be in the records is not claimed. In addition, the data represents nonfunctional descriptive information.),
 - wherein the server includes automated instructions that, when executed by the server (paragraph 64, password-all),
 - allow the customer
 - to advise the business of an upcoming payment for an upcoming event (figure 18, bill payment where the advise is performed verbally. This may also be considered the intended use of the presented data. paragraph 176, business meeting or faxed information),
 - to request a payment from the business for a previous event, or
 - to pair a payment with one or more previous events,

Art Unit: 3626

- wherein the automated instructions are adapted to present, on a computer graphical user interface for view and use by the customer, a list of open current account bookings of the customer (figures 17 and 18),

Kumar does not explicitly teach the system

- wherein the business is a reinsurer and the customer is an insurer
(However, the description of the customer and the business represents non-functional descriptive information and therefore has little patentable weight. Further, reversing the titles of the users so that the customer becomes the business and the business becomes the customer does not affect the outcome of the method; reversing the titles only changes the description of the users); and
 - wherein the open current account bookings are associated with more than one insurance policy (figure 16, #303. The Examiner notes that the association is not defined. Paragraph 227, insurance accounts is plural. Additionally, the association represents nonfunctional descriptive information), and
 - wherein, using the list, the customer is able to pair a payment associated with a certain insurance policy with a previous event associated with the certain insurance policy (as understood, this limitation does not occur. Regardless, the bill pay screen, figure 18, allows a user to match a payment with an expense. The certain insurance policy is considered nonfunctional descriptive

Art Unit: 3626

information. The event, not defined, could be a previous payment or even the establishment of the policy).

However, King further teaches the system

- wherein the business is a reinsurer and the customer is an insurer (column 13, line 4 through column 14, line 3); and
 - wherein the open current account bookings are associated with more than one insurance policy (column 11, lines 9 – 25, policyholders and each policy), and
 - wherein, using the list, the customer is able to pair a payment associated with a certain insurance policy with a previous event associated with the certain insurance policy (column 11, lines 26 - 37).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add these features into Kumar. One of ordinary skill in the art at the time of the invention would have added these features

- The prior art differs from the claim by the substitution of some components. The substituted components were known. The technical ability existed to substitute the components as claimed and the result of the substitution is predictable.

18. As per claim 2, Kumar in view of King teaches the system of claim 1 as described above. Kumar further teaches the system wherein the previous event is submitted by the customer to the business (figure 18, bill).

Kumar does not explicitly teach the system wherein the previous event is a claim.

Art Unit: 3626

- wherein the previous event is a claim submitted by the customer to the business, and
 - wherein payment is owed to the customer for the claim(figure 18, bill).

As mentioned above within claim 1, the user labels represent nonfunctional descriptive information. Broadly, if user1 pays user2, changing the label of user1 to customer and user2 to business is a simple title substitution.

The description of the transaction type further represents nonfunctional descriptive information. Changing the transaction from a credit card to an insurance claim is an obvious substitution of transaction types.

However, King further teaches the system

- wherein the previous event is a claim submitted by the customer to the business (figure 6 and column 17, line 45 through column 18, line 10) , and
 - wherein payment is owed to the customer for the claim (column 13, line 4 through column 14, line 3).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add this feature into Kumar. One of ordinary skill in the art at the time of the invention would have added this feature

19. As per claim 3, Kumar in view of King teaches the system of claim 2 as described above. Kumar does not explicitly teach the system wherein the claim relates to an insurance claim (As with claim 2, the claim description is nonfunctional).

However, King further teaches the system wherein the claim relates to an insurance claim (column 9, lines 2 - 8).

Art Unit: 3626

It would have been obvious to one of ordinary skill in the art at the time of the invention to add this feature into Kumar. One of ordinary skill in the art at the time of the invention would have added this feature

- The prior art differs from the claim by the substitution of some components. The substituted components were known. The technical ability existed to substitute the components as claimed and the result of the substitution is predictable.

20. As per claim 4, Kumar in view of King teaches the system of claim 1 as described above. Kumar further teaches the system wherein the upcoming event is a premium payment (figure 18, State Farm insurance and paragraph 227 where the description of the payment is nonfunctional). Kumar does not explicitly teach the system wherein the upcoming event is a premium payment for an insurance policy. However, Kumar shows describes managing insurance accounts (paragraph 227) and shows paying on an insurance account (figure 18). There are a limited number of payment possibilities within managing insurance accounts and selecting payment on a policy is an obvious choice.

21. As per claim 5, Kumar in view of King teaches the system of claim 1 as described above. Kumar further teaches the system comprising: a computer in communication with the server (figure 7, #163 and #167), wherein the customer accesses the server through the computer (figure 7, #163).

22. As per claim 6, Kumar in view of King teaches the system of claim 5 as described above. Kumar further teaches the system wherein the access to the server from the computer includes use of the Internet (paragraph 2).

Art Unit: 3626

23. As per claim 7, Kumar in view of King teaches the system of claim 5 as described above.

Kumar further teaches the system wherein the access to the server from the computer is remote (paragraph 18).

24. As per claim 8,

Kumar teaches a system for transacting business between a customer and a business, the system comprising:

- a server used by the business and being accessible by the customer (figure 1, #31 where the location of the server is not claimed),
 - a customer account housed on the server (paragraph 66 – 68),
 - the customer account being configured to permit access to individual records associated with the customer account (paragraph 67, on-line banking. The Examiner notes that the information required to be in the records is not claimed. In addition, the data represents nonfunctional descriptive information.),
 - the customer account having at least one associated process to be executed by the server (figure 3, login),
 - wherein the server includes automated instructions that are adapted to present, on a computer graphical user interface for view and use by the customer (paragraph 64, password-all and figure 3, #66),
 - a list of open current account bookings of the customer (figure 10),

Kumar does not explicitly teach the system

Art Unit: 3626

- wherein the business is a reinsurer and the customer is an insurer
(However, the description of the customer and the business represents non-functional descriptive information and therefore has little patentable weight. Further, reversing the titles of the users so that the customer becomes the business and the business becomes the customer does not affect the outcome of the method; reversing the titles only changes the description of the users); and
 - wherein the open current account bookings are associated with more than one insurance policy (figure 16, #303. The Examiner notes that the association is not defined. Paragraph 227, insurance accounts is plural. Additionally, the association represents nonfunctional descriptive information), and
 - wherein, using the list, the customer is able to pair a payment associated with a certain insurance policy with a previous event associated with the certain insurance policy (as understood, this limitation does not occur. Regardless, the bill pay screen, figure 18, allows a user to match a payment with an expense. The certain insurance policy is considered nonfunctional descriptive information. The event, not defined, could be a previous payment or even the establishment of the policy).

However, King further teaches the system

Art Unit: 3626

- wherein the business is a reinsurer and the customer is an insurer (column 13, line 4 through column 14, line 3); and
 - wherein the open current account bookings are associated with more than one insurance policy (column 11, lines 9 – 25, policyholders and each policy), and
 - wherein, using the list, the customer is able to pair a payment associated with a certain insurance policy with a previous event associated with the certain insurance policy (column 11, lines 26 - 37).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add these features into Kumar. One of ordinary skill in the art at the time of the invention would have added these features

- The prior art differs from the claim by the substitution of some components. The substituted components were known. The technical ability existed to substitute the components as claimed and the result of the substitution is predictable.

25. As per claim 9, Kumar in view of King teaches the system of claim 8 as described above.

Kumar does not explicitly teach the system

- wherein the previous event is a claim submitted by the customer to the business (figure 18, bill) , and
 - wherein payment is owed to the customer for the claim.

However, King further teaches the system

Art Unit: 3626

- wherein the previous event is a claim submitted by the customer to the business (figure 6 and column 17, line 45 through column 18, line 10) , and
 - wherein payment is owed to the customer for the claim (column 13, line 4 through column 14, line 3).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add this feature into Kumar. One of ordinary skill in the art at the time of the invention would have added this feature

As mentioned above within claim 1, the user labels represent nonfunctional descriptive information. Broadly, if user1 pays user2, changing the label of user1 to customer and user2 to business is a simple title substitution.

The description of the transaction type further represents nonfunctional descriptive information. Changing the transaction from a credit card to an insurance claim is an obvious substitution of transaction types.

- The prior art differs from the claim by the substitution of some components. The substituted components were known. The technical ability existed to substitute the components as claimed and the result of the substitution is predictable.

26. As per claim 10, Kumar in view of King teaches the system of claim 9 as described above.

Kumar does not explicitly teach the system wherein the claim relates to an insurance claim (As with claim 2, the claim description is nonfunctional).

However, King further teaches the system wherein the claim relates to an insurance claim (column 9, lines 2 - 8).

Art Unit: 3626

It would have been obvious to one of ordinary skill in the art at the time of the invention to add this feature into Kumar. One of ordinary skill in the art at the time of the invention would have added this feature

- The prior art differs from the claim by the substitution of some components. The substituted components were known. The technical ability existed to substitute the components as claimed and the result of the substitution is predictable.

27. As per claim 11, Kumar in view of King teaches the system of claim 8 as described above.

Kumar further teaches the system wherein the upcoming event is a premium payment (figure 18, State Farm insurance and paragraph 227 where the description of the payment is nonfunctional). Kumar does not explicitly teach the system wherein the upcoming event is a premium payment for an insurance policy. However, Kumar shows describes managing insurance accounts (paragraph 227) and shows paying on an insurance account (figure 18). There are a limited number of payment possibilities within managing insurance accounts and selecting payment on a policy is an obvious choice.

28. As per claim 12, Kumar in view of King teaches the system of claim 8 as described above.

Kumar further teaches the system comprising: a computer in communication with the server (figure 7, #163 and #167), wherein the customer accesses the server through the computer (figure 7, #163).

Art Unit: 3626

29. As per claim 13, Kumar in view of King teaches the system of claim 12 as described above. Kumar further teaches the system wherein the access to the server from the computer includes use of the Internet (paragraph 2).

30. As per claim 14, Kumar in view of King teaches the system of claim 12 as described above. Kumar further teaches the system wherein the access to the server from the computer is remote (paragraph 18).

31. As per claim 15,

Kumar teaches a method of transacting business between a customer and a business, the method comprising:

- accessing an existing customer account, including internal records of the business, on a server used by the business (paragraph 67, on-line banking. The Examiner notes that the information required to be in the records is not claimed. In addition, the data represents nonfunctional descriptive information.),
- accessing a computer graphical user interface that displays a list of open current account bookings of the customer (figures 17 and 18),
 - instructing the business
 - to make an upcoming payment for an upcoming event (figure 18, bill payment where the advise is performed verbally. This may also be considered the intended use of the presented data. paragraph 176, business meeting or faxed information),
 - to request a payment from the business from a previous event, or
 - to pair a payment with one or more upcoming events,

Art Unit: 3626

Kumar does not explicitly teach the method

- wherein the business is a reinsurer and the customer is an insurer (However, the description of the customer and the business represents non-functional descriptive information and therefore has little patentable weight. Further, reversing the titles of the users so that the customer becomes the business and the business becomes the customer does not affect the outcome of the method; reversing the titles only changes the description of the users);
- wherein the open current account bookings are associated with more than one insurance policy (figure 16, #303. The Examiner notes that the association is not defined. Paragraph 227, insurance accounts is plural. Additionally, the association represents nonfunctional descriptive information), and
 - wherein instructing the business to pair a payment with one or more upcoming events comprises using the list to pair a payment associated with a certain insurance policy with an upcoming event associated with the certain insurance policy (bill pay screen, figure 18, allows a user to match a payment with an expense. The certain insurance policy is considered nonfunctional descriptive information. The event, not defined, could be a previous payment or even the establishment of the policy).

However, King further teaches the method

- wherein the business is a reinsurer and the customer is an insurer (column 13, line 4 through column 14, line 3);

Art Unit: 3626

- wherein the open current account bookings are associated with more than one insurance policy (column 11, lines 9 – 25, policyholders and each policy), and
 - wherein instructing the business to pair a payment with one or more upcoming events comprises using the list to pair a payment associated with a certain insurance policy with an upcoming event associated with the certain insurance policy (column 11, lines 26 - 37).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add these features into Kumar. One of ordinary skill in the art at the time of the invention would have added these features

- The prior art differs from the claim by the substitution of some components. The substituted components were known. The technical ability existed to substitute the components as claimed and the result of the substitution is predictable.

32. As per claim 16, Kumar in view of King teaches the method of claim 15 as described above.

Kumar does not explicitly teach the method

- wherein the previous event is a claim submitted by the customer to the business (figure 18, bill) , and
 - wherein payment is owed to the customer for the claim.

However, King further teaches the method

- wherein the previous event is a claim submitted by the customer to the business (figure 6 and column 17, line 45 through column 18, line 10) , and

Art Unit: 3626

- wherein payment is owed to the customer for the claim (column 13, line 4 through column 14, line 3).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add this feature into Kumar. One of ordinary skill in the art at the time of the invention would have added this feature

As mentioned above within claim 1, the user labels represent nonfunctional descriptive information. Broadly, if user1 pays user2, changing the label of user1 to customer and user2 to business is a simple title substitution.

The description of the transaction type further represents nonfunctional descriptive information. Changing the transaction from a credit card to an insurance claim is an obvious substitution of transaction types.

- The prior art differs from the claim by the substitution of some components. The substituted components were known. The technical ability existed to substitute the components as claimed and the result of the substitution is predictable.

33. As per claim 17, Kumar in view of King teaches the method of claim 16 as described above.

Kumar does not explicitly teach the method wherein the claim relates to an insurance claim (As with claim 2, the claim description is nonfunctional).

However, King further teaches the method wherein the claim relates to an insurance claim (column 9, lines 2 - 8).

Art Unit: 3626

It would have been obvious to one of ordinary skill in the art at the time of the invention to add this feature into Kumar. One of ordinary skill in the art at the time of the invention would have added this feature

- The prior art differs from the claim by the substitution of some components. The substituted components were known. The technical ability existed to substitute the components as claimed and the result of the substitution is predictable.

34. As per claim 18, Kumar in view of King teaches the method of claim 15 as described above.

Kumar further teaches the method wherein the upcoming event is a premium payment (figure 18, State Farm insurance and paragraph 227 where the description of the payment is nonfunctional). Kumar does not explicitly teach the method wherein the upcoming event is a premium payment for an insurance policy. However, Kumar shows describes managing insurance accounts (paragraph 227) and shows paying on an insurance account (figure 18). There are a limited number of payment possibilities within managing insurance accounts and selecting payment on a policy is an obvious choice.

35. As per claim 19, Kumar in view of King teaches the method of claim 15 as described above. Kumar further teaches the method wherein accessing the customer account involves use of the Internet (paragraph 2).

36. As per claim 20, Kumar in view of King teaches the method of claim 15 as described above. Kumar further teaches the method wherein the customer account is accessed remotely (paragraph 18).

Art Unit: 3626

37. As per claim 23, Kumar in view of King teaches the system of claim 8 as described above. Kumar further teaches the system wherein the process is at least one of

- advising the business of an upcoming payment for an upcoming event (figure 18, bill payment where the advise is performed verbally. This may also be considered the intended use of the presented data. paragraph 176, business meeting or faxed information),
- request a payment from the business from a previous event or
- to pair a payment with one or more previous events.

38. As per claim 24,

Kumar teaches a method comprising:

- remotely accessing an account (paragraph 18),

Kumar does not explicitly teach the method

- remotely accessing an insurer account by an insurer (However, the description of the user account and the user represents non-functional descriptive information and therefore has little patentable weight.),
 - including internal records of a reinsurer providing coverage to the insurer for clients of the insurer (paragraph 67, on-line banking. The Examiner notes that the information required to be in the records is not claimed. In addition, the data represents nonfunctional descriptive information.),
 - the account being stored on a server associated with the reinsurer (figure 16, as above, they type of association is not known);

Art Unit: 3626

- accessing a computer graphical user interface that displays a list of open current account bookings associated with the insurer (figure 16, #303. The Examiner notes that the association is not defined. Paragraph 227, insurance accounts is plural. Additionally, the association represents nonfunctional descriptive information),
 - wherein the open current account bookings are associated with an insurance policy in which the reinsurer provides reinsurance coverage to the insurer (figure 18, state farm) , and
- instructing the reinsurer to pair a payment with one or more upcoming events (The Examiner notes that a payment may be to match a bill with a payment. Paragraphs 229 and 230),
 - the instructing performed by the insurer using the server associated with the reinsurer (paragraph 232, pay bills),
 - wherein instructing the reinsurer to pair a payment with one or more upcoming events comprises using the list to pair a payment associated with a certain insurance policy of the insurer with an upcoming event associated with the certain insurance policy in accordance with an existing reinsurance policy between the insurer and the reinsurer (bill pay screen, figure 18, allows a user to match a payment with an expense. The certain insurance policy is considered nonfunctional descriptive information. The event, not defined, could be a previous payment or even the establishment of the policy).

However, King further teaches the method

- remotely accessing an insurer account by an insurer (column 6, lines 15 – 38, where the insurer is a party of interest accessing the account at the intermediary computer. The design of the network represents a design choice of making the components integral or separable.),
 - including internal records of a reinsurer providing coverage to the insurer for clients of the insurer (figure 2, where the intermediary allows record access),
 - the account being stored on a server associated with the reinsurer (figure 2);
 - accessing a computer graphical user interface that displays a list of open current account bookings associated with the insurer (column 11, lines 9 – 25, policyholders and each policy),
 - wherein the open current account bookings are associated with an insurance policy in which the reinsurer provides reinsurance coverage to the insurer (Example 2 and II. Primary shareholders), and
 - instructing the reinsurer to pair a payment with one or more upcoming events (I. Transactional Capital Participants and column 13, line 4 through column 14, line 3),
 - the instructing performed by the insurer using the server associated with the reinsurer (I. Transactional Capital Participants and column 13, line 4 through column 14, line 3),

Art Unit: 3626

- wherein instructing the reinsurer to pair a payment with one or more upcoming events comprises using the list to pair a payment associated with a certain insurance policy of the insurer with an upcoming event associated with the certain insurance policy in accordance with an existing reinsurance policy between the insurer and the reinsurer (column 11, lines 26 - 37).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add these features into Kumar. One of ordinary skill in the art at the time of the invention would have added these features

- The prior art differs from the claim by the substitution of some components. The substituted components were known. The technical ability existed to substitute the components as claimed and the result of the substitution is predictable.

39. As per claim 26, Kumar in view of King teaches the method of claim 24 as described above.

Kumar, as understood, does not explicitly teach the method wherein instructing the reinsurer to make an upcoming payment includes off-setting debit and credit items for the insurer. (The Examiner notes that a payment may be to match a bill with a payment. Paragraphs 229 and 230), However, King, as understood, further teaches the method wherein instructing the reinsurer to make an upcoming payment includes off-setting debit and credit items for the insurer. (I. Transactional Capital Participants and column 13, line 4 through column 14, line 3),

Art Unit: 3626

It would have been obvious to one of ordinary skill in the art at the time of the invention to add this feature into Kumar. One of ordinary skill in the art at the time of the invention would have added this feature

- The prior art differs from the claim by the substitution of some components. The substituted components were known. The technical ability existed to substitute the components as claimed and the result of the substitution is predictable.

40. As per claim 27, Kumar in view of King teaches the method of claim 24 as described above.

Kumar further teaches the method comprising generating a record of the payment made (paragraph 152, account history where the details represent nonfunctional data).

Kumar does not explicitly teach the method generating a record of the payment made with the certain insurance policy.

However, King further teaches the method generating a record of the payment made with the certain insurance policy (column 24, line 1 – 11).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add this feature into Kumar. One of ordinary skill in the art at the time of the invention would have added this feature

- The prior art differs from the claim by the substitution of some components. The substituted components were known. The technical ability existed to substitute the components as claimed and the result of the substitution is predictable.

Art Unit: 3626

41. **Claim 21** is rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar et al., U.S. Pre-Grant Publication 2001/ 0023414 in view of King et al., U.S. Patent 5,704,045, as applied to claim 1 above, further in view of AAPA.

42. As per claim 21, Kumar in view of King teaches the system of claim 1 as described. Kumar in view of King further teaches the system wherein the customer advises of an upcoming payment by selecting postings on the list (figure 2 where payment terms are described). Kumar in view of King does not explicitly teach the system wherein the automated instructions are adapted to verify that the sum of all selected postings is in the business's favor.

It is AAPA that the automated instructions are adapted to verify that the sum of all selected postings is in the business's favor.

One of ordinary skill in the art at the time of the invention would have added the Official Notice feature to Lundegren. One of ordinary skill in the art would have added this feature with the motivation to clearly see all the positions of a business or a customer online to make determining profits easier (AAPA).

43. **Claim 22** is rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar et al., U.S. Pre-Grant Publication 2001/ 0023414 in view of King et al., U.S. Patent 5,704,045, as applied to claim 1 above, further in view of Goino, U.S. Pre-Grant Publication Number 2001/ 0056396.

44. As per claim 22, Kumar in view of King teaches the system of claim 1 as described. Kumar in view of King does not explicitly teach the system wherein the customer requests a payment by selecting postings on the list, and wherein the automated instructions are adapted to verify that the sum of all selected postings is in the customer's favor.

Art Unit: 3626

However, Goino teaches the system wherein the customer requests a payment by selecting postings on the list (paragraph 371 where a bidders list is shown), and wherein the automated instructions are adapted to verify that the sum of all selected postings is in the customer's favor (paragraph 372).

One of ordinary skill in the art at the time of the invention would have added these features to Kumar in view of King. One of ordinary skill in the art would have added these features with the motivation to satisfy that requirements other than the price for a client are provided (Goino abstract).

45. **Claim 25** is rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar et al., U.S. Pre-Grant Publication 2001/ 0023414 in view of King et al., U.S. Patent 5,704,045, as applied to claim 24 above, further in view of CATEX, web-based clearing and settlement.

46. As per claim 25, Kumar in view of King teaches the method of claim 24 as described above.

Kumar in view of King does not explicitly teach the method wherein the insurer account includes a bordereaux (The use of a bordereau represents a matter of design choice).

However, CATEX further teaches the method wherein the insurer account includes a bordereaux (Press Release – CATEX Details Web-Based Clearing and Settlement).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add this feature into Kumar in view of King. One of ordinary skill in the art would have added this feature into Kumar in view of King

Art Unit: 3626

- The elements are all known but not combined as claimed. The technical ability exists to combine the elements as claimed and the results of the combination are predictable.

When combined, the elements perform the same function as they did separately.

Response to Arguments

47. Applicant's arguments, see 35 U.S.C. 112, 1st paragraph rejection, filed 3/31/2009, with respect to claim 24 have been fully considered and are persuasive. The 35 U.S.C. 112, 1st paragraph rejection of claim 24 has been withdrawn.

48. Applicant's arguments, see 35 U.S.C. 112, 2nd paragraph rejection, filed 3/31/2009, with respect to claim 8 – 14 and 23 have been fully considered and are persuasive. The 35 U.S.C. 112, 2nd paragraph rejection of claim 8 – 14 and 23 has been withdrawn.

49. Applicant's arguments with respect to claims 1 – 27 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

50. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kraehenbuehl et al., U.S. Pre-Grant Publication 2002/ 0046067

Laurenzano, U.S. Pre-Grant Publication 2002/ 0046066

Catex brochure

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NEAL R. SEREBOFF whose telephone number is (571)270-1373. The examiner can normally be reached on Mon thru Thur from 7:30am to 5pm, with 1st Fri off.

Art Unit: 3626

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Luke Gilligan can be reached on (571) 272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Neal R Sereboff/
Examiner, Art Unit 3626
9/9/2009